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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,150	02/13/2002	Yasushi Yamade	325772027900	5457

7590

10/20/2005

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EXAMINER
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REILLY, SEAN M

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/073,150	Applicant(s) YAMADE, YASUSHI	
	Examiner Sean Reilly	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This office is in response to Applicant's request for reconsideration filed 7/6/2005.

Claims 1-11 are presented for further examination.

Examiner agrees with Applicant that the claims are definite as written however the Examiner still maintains that the claims are cumbersome and should be rewritten using clearer language. This action is made NON-FINAL to properly address the claims in view of Applicant's comments and clarification. The previous 101 rejection is withdrawn in view of Applicant's amendment.

In the event that Applicant refuses to clarify the claims, for clarification of the record the following is noted. With regard to the following limitation of claim 1, *setting means for, during multi-destination delivery in which multiple destination are designed, where the destinations include those for which the first transmission mode is designated as well as those for which the second transmission mode is designated, setting the third transmission mode for the destinations for which the first transmission mode is designated in place of the first transmission mode and* the following limitation of claims 6 and 9, *setting the third transmission mode for the destination for which the first transmission mode is designated in place of the first transmission mode when it is determined that the destinations include those for which the first transmission mode is designated as well as those for which the second transmission mode is designated;* the recited limitations are interpreted as follows: all destinations which specify the *first mode* of transmission **must instead** use the *third mode* of transmission **only when both** the first **and**

second transmission modes have been selected within the group of transmission modes of the plurality of destinations.

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed. The effective filing date for the subject matter defined in the pending claims in this application is 3/13/2001.

***Specification***

2. The new title submitted by Applicant on 7/6/2005 has been entered into the record.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakimoto (U.S. Patent Number 6,775,688) and Ramaley et al. (U.S. Patent Number 6,687,741; hereinafter Ramaley).
4. Regarding claims 1, 6, 9, and 12, Kakimoto discloses a method for use with a data transmission device, comprising the following steps of:

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- receiving an instruction (Data Distribution Method Figure 5, Component 47) to designate for each destination (for multiple destinations see Figure 4) one of a first transmission mode in which a file is sent attached to an e-mail message (Col 2, lines 12-17 or Col 8, lines 23-28), a second transmission mode in which a file is sent to a file transfer server (real data Col 2, lines 8-11 or Col 8, lines 23-28) and a third transmission mode in which a file is sent to a file transfer server and an e-mail message having a text string including address information of the file transfer server is sent (Link) (Link data transfer Col 2, lines 4-7 or Col 8, lines 23-28) (also refer to Figure 6A);
- determining during multiple-destination delivery in which multiple destinations are designated (e.g. multiple recipients and their respective email addressees) whether or not the destinations include those for which the first transmission mode is designated as well as those for which the second transmission mode is designated (for instance NOT is selected); and
- setting the third transmission mode for the destinations for which the first transmission mode is designated in place of the first transmission mode (see Figure 6A, when the traffic load is heavy, S527, the system distributes the data as link data instead of an email attachment).

Kakimoto disclosed the invention substantially as claimed however, Kakimoto failed to specifically recite replacing the first transmission mode with the second transmission mode *when it is determined that the destinations include those for which the first transmission mode is*

*designated as well as those for which the second transmission mode is designated.* Nonetheless it was well known in the art at the time of the invention to replace an e-mail attachment sending mode with a file upload and e-mail link sending mode, when both email attachment and file uploads sending modes are selected, as evidenced by Ramaley. In an analogous art, Ramaley disclosed a system where users can send files using various modes of transmission, e.g. e-mail attachment, to a file transfer server (shared disk location), and to a file transfer server and a link in an email (Col 7, line 30 – Col 8, line 17). In Ramaley's system when a user selects to send a file as an attachment and the file is selected to be saved to a file transfer server, the system automatically sends the file using a link in an email as opposed to an email attachment (see inter alia Col 7, line 30 – Col 8, line 17, where the system checks to see if the user uploads the file to a shared disk). Ramaley further disclosed that it is preferable to send files as links in e-mails when the files are going to be stored in shared drives since the recipient is able to access the shared file even after it has been subsequently modified by the sender and thus provides greater levels of data concurrency (Col 5, line 64 – Col 6, line 1). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system Kakimoto to send files in email link mode when the file is selected to be sent via email attachment and uploaded to a file transfer server, so that the recipient is able to access the shared file even after it has been subsequently modified by the sender and therefore provide greater levels of data concurrency.

5. Regarding claim 2, Kakimoto discloses data generating means for generating image data, and wherein the file to be sent comprises the image data generated by the data generating means (Col 7, lines 1-4 and Figure 6A Convert to distributable data form).

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6. Regarding claim 3, Kakimoto discloses an image reader for reading an image of an original document and outputting image data, and wherein the file to be sent comprises the image data output by the image reader (Col 7, lines 1-4 and Figure 6A Convert to distributable data form).

7. Regarding claims 4, 7, and 10, Kakimoto discloses the file transfer server address information includes an address of the server and a name of the folder in which the file is to be stored (Data Location, Figure 8 and Col 10, line 66 – Col 11, line 17). Further Ramaley disclosed that the file transfer server is an FTP server (Col 7, lines 63-65).

8. Regarding claims 5, 8, and 11, Kakimoto fails to specifically recite that the text string of the e-mail message in the third transmission mode includes a user ID and password for authentication purposes. However Kakimoto disclose the file transfer server has an access authority authentication function (Col 12, lines 52-56). Further it was well known in the art at the time of the invention to use a user ID and password for authentication purposes. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a user ID and password within the text string of the e-mail message (link data in Kakimoto) in order to provide a user access to the secure file server.

### *Conclusion*

9. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

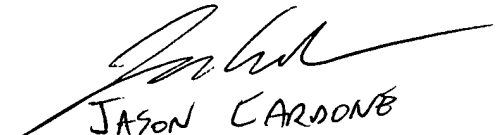
10. This office action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/12/2005

  
JASON CARDONE  
SPE A2145